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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,671	12/29/1999	CASSANDRA J. MOLLETT	34250-0878	2544
7590 12/23/2008				
Malvern U. Griffin III SUTHERLAND ASBILL & BRENNAN LLP 999 Peachtree Street, N.E. Atlanta, GA 30309-3996				
EXAMINER				
RUDY, ANDREW J				
ART UNIT		PAPER NUMBER		
3687				
MAIL DATE		DELIVERY MODE		
12/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/474,671

Applicant(s)

MOLLETT ET AL.

Examiner

Andrew Joseph Rudy

Art Unit

3687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

1. Claims 1-6, 8 and 9 are pending. Pursuant to the December 3, 2008 Administrative Remand from the Board of Appeals of the United States Patent and Trademark Office, prosecution is reopened.

DETAILED ACTION

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6, 8 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Pursuant to a May 15, 2008 Memorandum from John J. Love, Deputy Commissioner for Patent Examination Policy, United States Patent and Trademark Office (memo), in conjunction with the recent *Bilski* decision decided in 2008 by the Court of Appeals for the Federal Circuit (CAFC), In re **Bilski**, ___ F.3d ___ (Fed. Cir. 2008)(en banc), the claims 1-6, 8 and 9 are non-statutory as the claims are not tied to a statutory class nor transform the underlying subject matter to a different state or thing. Further, the claims may be practiced by hand, e.g. no computer process is involved, and pen, paper and calculations made thereon/therewith may fully meet the claim language.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-6, 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The aforementioned 35 USC 101 rejection does not allow the examiner to understand the meets and bounds of Applicant's claim language.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8, line 10, "the time period" lacks antecedent basis. It is not clear from claim 8 if "the time period" is the "one time period from line 2, or "each of the at least one time period" from lines 5 or 8. As is, it is not clear what is being referenced.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Templeton.

Walker discloses a system for approving a money limit for a time period comprising: storing historical data in a central controller 12 and authorizing the charge, e.g. 362, of an entity if a credit score, e.g. cols. 10-11, is acceptable so that funds may be collected over a time period, e.g. installment plan database 50, Fig. 13, depending upon the classification of the entity from a plurality of stores, e.g. 14, 16, 18. The credit scoring of Walker is deemed to be within a range of scores and is deemed to comprise the word scrubbed. Walker does not specifically disclose a check cashing and a check writer using his system, though he does disclose credit situations that are parallel to check writing.

Templeton discloses, e.g. Fig. 1, a method using a computer for determining whether to collect from check writers from data comprising a negative file 85, a positive file 87 containing identification information and a credit risk scoring algorithm, e.g. cols. 12-14.

Templeton does not specifically indicate a time period, but does indicate that the negative file 85 is "continuously updated" (col. 12, line 59) and that the positive file 87 is used (col. 13, lines 18-34) to determine suitability of cashing a check. Templeton inherently contains categories to ascertain whether a check will be honored or not. It is

common knowledge and well known in the art that various specified time periods are used by financial institutions, e.g. a bank or a traditional "mom and pop" grocery store, when assessing whether or not to cash a check, e.g. an entity may hold ones check over a time period before deciding to cash the check.

To have provided the various specified time periods for Walker to have comprised a checking system similar to Templeton, would have been obvious to one of ordinary skill in the art. Doing such would use well known time period factors to provide a more complete and updated database fro risk assessment when cashing a check. To have provided the negative file of Walker, as modified by Templeton, to comprise a scrubbed file would have been obvious to one of ordinary skill in the art.

Applicant's ARGUMENTS regarding the rejection of claims 1-6, 8 and 9 under 35 U.S.C. 103 are noted, but not agreed with.

Applicant's assertion that Walker does not show a time period or money limit or check cashing is opposite to Walker's disclosure, e.g. cols. 9-10, lines 54-23. Initially, it is noted that intended use, e.g. "for a time period" recited in claim 1 do not provide positive claim recitations that further limit Applicant's method claims. Nonetheless, the time period in Walker is indirectly referenced when the when the account is in good standing and not past due. To be past due there must be a time period, e.g. a monthly account statement, that the purchaser of the credit must, generally, pay off in total or an appropriate portion thereof, a suitable balance in order to have access to the financial account. It has been common knowledge that time periods are used in both the credit and check cashing industry to facilitate accounting and transaction objectives, e.g. to

verify whether a user has a proper credit history and financial resources to cover the requested fund transfer. The electronic credit card purchases disclosed by Walker encompass in broad scope and content the check cashing language recited by Applicant. Apparently, Applicant implies or would have one believe a traditional "paper" check is required from the claim language. No such limitations exists within the claim language. As recited, an electronic check credit card fully meets Applicant's claim language.

Applicant's ARGUMENTS that no attempt to match the recited elements of Applicant's claims to Walker is noted. See Paper No. 15, pages 4-5, for matching limitations that meet in broad scope and content Applicant's claim language.

Similarly, Applicant's assertion that Templeton does not show a checking function on any time period is opposite to Templeton's disclosure. Though Templeton does not explicitly disclose a time period, it would be inherent aspect of Templeton's disclosure. The real-time updating of file information, e.g. 85, 87, of Templeton, fully meets the broad scope and content of Applicant's "time period" referenced. As is, the time period may be as short as a nano-second or as long as a year (or longer) to fully meet Applicant's claim language. In sum, the real-time period parameters disclosed by Templeton fully meet Applicant's claim language.

The assertion that the Examiner robs Applicant of the ability to properly from an argument rebutting obviousness or to narrow the claims around the prior art are subjective comments. However, the Examiner is not in agreement with this assertion.

Regarding subscores from claim 3, the positive file 87 and negative file 85 are deemed in broad scope and content to fully encompass this term. Further, the historical approval criteria data of Walker may be viewed to comprise a subscore. As is, the claim 3 terminology does not define over Walker, as modified by Templeton.

Regarding claim 8, as understood, the historical approval criteria data of Walker may be viewed as meeting the claim terminology for approving a check cashing request for each time period being considered. Thus, claim 8, as understood, does not define over Walker, as modified by Templeton.

Regarding claim 9, the historical approval criteria data of Walker may be viewed as meeting the claim terminology for approving a check cashing request for each time period being considered. Further, allowing a check writer to reach his/her credit limit over a specified time period after having a previous financial transaction has been approved have been common knowledge in check cashing systems. Both the Walker and Templeton systems allow for this function to be performed. Thus, claim 9 does not define over Walker, as modified by Templeton.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Joseph Rudy whose telephone number is 571-272-6789. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew Joseph Rudy/
Primary Examiner, Art Unit 3687